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No.

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM 1998

WILLIAM BRADSHAW and ROBERT SHEPHERD,
Petitioners,

v.

IGLOO PRODUCTS CORPORATION,
Respondent.

On Petition For Writ Of Certiorari
To The United States Court Of Appeals
For The Federal Circuit

PETITION FOR WRIT OF CERTIORARI

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36pp

QUESTION PRESENTED FOR REVIEW

Whether application of the doctrine of equivalents in a patent infringement lawsuit is a task for the judge or for the jury when there is no prosecution history estoppel, no prior art bar limitations or any express finding that no reasonable jury could find equivalents.

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OPINIONS BELOW

The unpublished panel opinion of the United States Court of Appeals for the Federal Circuit (hereinafter referred to as the "Federal Circuit") sought to be reviewed is not reported. (1a).[1] The order of the Federal Circuit denying the petition for rehearing and suggestion for rehearing in banc is not reported. (11a). The opinion of the United States District Court for the Northern District of Illinois, Eastern Division (hereinafter referred to as the "District Court)", entered in this matter on December 2, 1997 making its opinion of August 25, 1997 final and appealable is not reported. The opinion of the District Court entered in this matter on August 25, 1997 granting the renewed motion of Igloo Products Corporation (hereinafter referred to as "Igloo") for summary judgment is not reported. The unpublished panel opinion of the Federal Circuit entered in this matter on November 15, 1996 is reported at 101 F.3d 716 (Table). The opinion of the District Court entered in this matter on January 5, 1996 granting Igloo's original motion for summary judgment is reported at 912 F.Supp. 1088.

JURISDICTION

The opinion of the Federal Circuit sought to be reviewed was entered on September 18, 1998. (1a). The order of the Federal Circuit denying the Petitioners' petition for rehearing and suggestion for rehearing in banc was entered on October 28, 1998. (11a). The jurisdiction of this Court is invoked under 28 U.S.C. § 1254.

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[1] Citations to the Appendix bound with this Petition shall appear as (___a).

STATUTORY PROVISIONS INVOLVED

35 U.S.C. § 111 provides in pertinent part:

> Application for patent shall be made, or authorized to be made, by the inventor, except as otherwise provided in this title, in writing to the Commissioner. Such application shall include (1) a specification as prescribed by section 112 of this title ....

35 U.S.C. § 112 provides in pertinent part:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.
>
> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
>
> * * * *
>
> An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure,

material, or acts described in the specification and equivalents thereof.

35 U.S.C. § 271 provides in pertinent part:

> (a) Except as otherwise provided in this title, whoever without authority makes, uses or sells any patented invention, within the United States during the term of the patent therefor, infringes the patent.

STATEMENT OF THE CASE

Subject matter jurisdiction in the District Court is founded in 28 U.S.C. § 1338(a).

The Petitioners herein, William Bradshaw and Robert Shepherd (hereinafter referred to as "Bradshaw"), had an innovative idea for a cooler on wheels for which they were able to obtain patent coverage. Bradshaw then took this patent to the Respondent herein,Igloo Products Corporation (hereinafter referred to as "Igloo"), a large corporation which would be able to mass produce the product. However, instead of offering Bradshaw a reasonable licensing agreement, Igloo took the design contained in the patent and copied all the elements, except a functional cooling compartment, into an otherwise literally infringing prototype. Igloo created sales based on that prototype and then, prior to distribution of the product, altered it so slightly that its own customers did not notice any difference. Protecting patent holders from minute and insubstantial changes, as occurred in this case, is the reason this Court adopted the doctrine of equivalents in *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 339 U.S. 605 (1950).

In *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17**, 117 S.Ct. 1040 (1997), this Court reaffirmed

the doctrine of equivalents as a viable option for a patent holder to prove infringement in the absence of literal infringement. Although presented with the issue of whether the application of the doctrine of equivalents is a task for the judge or for the jury, this Court previously declined to consider the issue since resolution of the issue was not necessary to answer the central question presented in that case. The time has come, however, for this Court to affirmatively decide this fundamental issue of patent law. In this case, the Federal Circuit applied the all-elements or all-limitations rule, as a rule of law, to deny the patent holder the right to a factual determination by a jury of infringement under the doctrine of equivalents even though there was no prosecution history estoppel, no prior art limitations and no finding that no reasonable jury could find equivalents.

Bradshaw is the owner of U.S. Patent No. 4,873,841, entitled "Portable Cooler", which issued on October 17, 1989 (hereinafter referred to as the "Bradshaw patent"). The application was allowed on the first action of the Patent and Trademark Office with no prosecution history estoppel. The Bradshaw patent improved upon a conventional cooler which typically has a pair of lifting handles attached on opposite sides of the cooler as the only means of transporting the cooler. In contrast, the preferred embodiment of the Bradshaw patent discloses the attachment of a pair of wheels under one end of the cooler body and a pulling handle on the side of the cooler body opposite the wheels. This allows the user to easily pull a loaded cooler along the ground.

In January of 1990, Bradshaw contacted Igloo to determine whether it would be interested in licensing the Bradshaw patent. Through numerous correspondence during the period of January 1990 through April 1992, Bradshaw provided Igloo with several copies of the Bradshaw patent, several drawings of the preferred embodiment, a photograph

of a prototype of the preferred embodiment built by Bradshaw using an Igloo cooler, and a list of various national retailers interested in carrying the product. Despite Bradshaw's constant efforts, Igloo repeatedly refused the invitation to license the Bradshaw patent. Then, in May of 1992, Igloo informed Bradshaw that it had an ice chest with wheels in the design phase despite the fact that Igloo has no independent product development department.

In or about January of 1993, Igloo began the initial design of its Cool Roller product line. Igloo has stipulated that final prototypes of this line of wheeled coolers would have been literally covered by the claims of the Bradshaw patent except for the fact that the prototypes contained a wooden body rather than an insulated cooling compartment. These prototypes were used by Igloo in sales presentations to its top customers to create the first year of sales for the Cool Roller product line. When Bradshaw was made aware of this line of products, Bradshaw and Igloo once again entered into negotiations under which Igloo would purchase a licensing agreement for the Bradshaw patent. When the negotiations failed in or about November of 1993, Igloo's President told Igloo's Director of Engineering to separate the lifting handle and the pulling handle on the Cool Roller products from the same axis.

Igloo continued to copy the essential components of the Bradshaw patent when it modified the Cool Roller products. In an attempt to maintain the functionality of the Bradshaw patent, Igloo discovered through its research that the placement of the pulling handle, one of the innovative components of the Bradshaw patent, could not be altered due to simple human ergonomics. Igloo, therefore, moved the placement of the conventional lifting handle and attached it to a separate axle less than one inch below the axle for the pulling handle. Igloo's Director of Engineering testified that Igloo moved the lifting handle down the minimum distance

possible so as to maintain the maximum functionality of the product. The modified Cool Roller products were then shipped to Igloo's customers without notification that a change had been made from the prototype on which sales were based. The changes in the Cool Roller products were so insubstantial that Igloo's top customers signed affidavits stating they did not realize any changes had been made or that only insubstantial or cosmetic changes had been made between the prototype and the product received. In fact, Igloo stipulated to the mechanical equivalence between the final Cool Roller products and the Bradshaw patent.

Believing the Cool Roller products still infringed upon the Bradshaw patent, Bradshaw filed the original complaint in this action on October 28, 1994 alleging infringement both literally and under the doctrine of equivalents.[2]

On January 5, 1996, the District Court entered a Memorandum Opinion and Order in this matter granting summary judgment in favor of Igloo. The District Court held that, in light of prior art, Igloo's Cool Roller products did not infringe the Bradshaw patent either literally or under the doctrine of equivalents. Bradshaw timely filed an appeal from the District Court's decision.

On November 15, 1996, the Federal Circuit, in *Bradshaw v. Igloo Products Corp.*, 101 F.3d 716 (Fed. Cir. 1996) (Table), issued an opinion affirming the District Court's finding that Igloo's products do not literally infringe the Bradshaw patent. In its opinion, the Federal Circuit construed the claims of the Bradshaw patent to require: an insulated cooler with lifting handles on each end of the

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[2] The complaint also alleged infringement by Igloo of the Bradshaw patent by its Kool Locker a/k/a Rolling Kool Locker products. All claims in the complaint related to those products were subsequently dismissed without prejudice.

cooler; wheels attached to the bottom of the cooler on one end of the cooler; and a pulling handle attached to the lifting handle axle on the end of the cooler opposite the wheels. The Federal Circuit concluded that Igloo's Cool Roller products literally meet all but one element of the independent claims of the Bradshaw patent, specifically, the element requiring that the pulling handle be attached on the same axle as the lifting handle, and affirmed the District Court's finding of no literal infringement. The Federal Circuit, however, vacated the District Court's grant of summary judgment in favor of Igloo regarding possible infringement under the doctrine of equivalents and remanded the case back to the District Court for further consideration with explicit instructions regarding the prior art analysis.

On August 28, 1997, the District Court entered a Memorandum Opinion and Order granting Igloo's renewed motion for summary judgment as to its Cool Roller products finding that infringement under the doctrine of equivalents was barred by prior art. In rendering its opinion, the District Court ignored the explicit directions provided by the Federal Circuit regarding a proper prior art analysis. Bradshaw timely filed an appeal from the District Court's decision.

On September 18, 1998, the Federal Circuit in *Bradshaw v. Igloo Products Corp.*, Appeal No. 98-1157, issued the opinion which is sought to be reviewed. (1a). Although the Federal Circuit indicated that the District Court had once again erred in its analysis of the prior art, the Federal Circuit applied an alternative rule of law and affirmed the District Court's decision. There are only three known rules of law under which a patent holder may be denied a jury determination of equivalence: prosecution history estoppel, prior art and a determination that no reasonable jury could find equivalence. Despite none of these rules of law being applicable in this case, the Federal

Circuit held, "[T]he doctrine of equivalents may not legally cover the accused Cool Roller device." (9a). The Federal Circuit went on to hold, as a matter of law, that:

> [O]ne element of the...[Bradshaw] patent must be a handle support axle to which both a lifting handle and a pulling handle are attached. That element or limitation is entirely missing in the accused cooler and thus equivalent infringement fails under Pennwalt's all-elements or all-limitations rule. See Pennwalt, 833 F.2d at 935, 4 USPQ2d at 1740. (10a).

Under the guise of applying an alternative rule of law, the Federal Circuit essentially made a factual determination as to equivalents. Such a determination should be in the province of the fact-finder, more specifically, the jury. Clearly, in a case such as this where the alleged infringer admitted equivalence, a reasonable jury could find infringement under the doctrine of equivalents. Denying a patent holder the right to a factual determination of equivalents by a jury serves a grave injustice.

On October 1, 1998, Bradshaw timely filed a petition requesting that the Federal Circuit rehear this matter and suggesting that the matter be reheard in banc. An order was entered by the Federal Circuit on October 28, 1998 denying Bradshaw's petition. (11a).

ARGUMENT SUPPORTING ALLOWANCE OF THE WRIT

I. THERE IS A DISTINCT DIVISION BETWEEN THE JUSTICES OF THE FEDERAL CIRCUIT REGARDING WHETHER THE APPLICATION OF THE DOCTRINE OF EQUIVALENTS IS A TASK FOR THE JUDGE OR THE JURY.

In *Warner-Jenkinson*, this Court specifically held that the essential inquiry under the doctrine of equivalents is, "Does the accused product or process contain elements identical or equivalent to each claimed element of the patented invention?" *Warner-Jenkinson*, 520 U.S. at **, 117 S.Ct. at 1054. This approach to the doctrine of equivalents is, in essence, the same principle which has been applied by the Federal Circuit for more than a decade as the all elements or all-limitations rule (hereinafter referred to as the "all-elements rule"). *See, e.g., Pennwalt Corp. v. Durand-Wayland, Inc.*, 833 F.2d 931 (Fed. Cir. 1987) (in banc) and *Perkin-Elmer Corp. v. Westinghouse Elec. Corp.*, 822 F.2d 1528 (Fed. Cir. 1987).

This Court has made clear that the precise linguistic framework used when applying the doctrine of equivalents is irrelevant and is likely to vary depending upon the particular facts of the case. *Warner-Jenkinson*, 520 U.S. at **, 117 S.Ct. at 1054. This Court noted, however, that:

> An analysis of the role played by each element in the context of the specific patent claim will thus inform the inquiry as to whether a substitute element matches the function, way, and result of the claimed element, or whether the substitute element plays a role substantially different from the claimed element. *Id.*

In *Warner-Jenkinson*, this Court declined to take the final step and determine who is to perform such an analysis - the judge or the jury.

Sitting in banc, in the decision underlying this Court's decision in *Warner-Jenkinson*, a majority of the Federal Circuit held that, "Infringement, whether literal or under the doctrine of equivalents, is a question of fact." *Hilton Davis Chemical Co. v. Warner-Jenkinson Co., Inc.*, 62 F.3d 1512, 1520 (Fed. Cir. 1995) (in banc), *rev'd and remanded on other grounds*, 520 U.S. 17, 117 S.Ct. 1040 (1997). That majority of the Federal Circuit, seven justices in total, believed that the holding was made abundantly clear and was wholly supported by its own precedent and prior decisions of this Court. *Id.* at 1520, 1521. The majority left no room for doubt in the meaning of its holding by stating:

> ...[I]nfringement under the doctrine of equivalents is an issue of fact to be submitted to the jury in a jury trial with proper instructions, and to be decided by the judge in a bench trial. *Id.* at 1522.

There were, however, four justices who disagreed with the majority and wrote extensive and detailed dissenting opinions stating that the doctrine of equivalents is an equitable remedy to be determined solely by a judge. *See* dissenting opinion written by Circuit Judge Plager, with whom Chief Judge Archer Circuit Judges Rich and Lourie joined, *Hilton Davis*, 62 F.3d at 1536; and the dissenting opinion written by Circuit Judge Lourie with whom Circuit Judges Rich and Plager joined, *Hilton Davis*, 62 F.3d at 1545. Additionally, one justice stated in a separate opinion that the application of the doctrine of equivalents involves questions of both law and fact: the meaning of the claims is a question of law and the scope of protection afforded a patent is a question of law, but whether an accused product

meets each limitation of a claim either literally or by equivalents is a question of fact. *See* dissenting opinion written by Circuit Judge Nies, *Hilton Davis*, 62 F.3d at 1550.

This is not an instance in which it is appropriate to leave the Federal Circuit to its own devices in settling an important question of patent law. The Federal Circuit, in *Hilton Davis*, plainly did not feel itself empowered to solve the problems presented by the application of the doctrine of equivalents. Instead, at virtually every turn, each judge invoked what he or she regarded as binding precedent of this Court in concluding whether the task is one for the judge or the jury.

Amid this background, patentees are subject to the uncertainty of their case being decided based upon the potentially conflicting beliefs of the individual members of the panel randomly selected to hear their case. Without a determination of this issue by this Court, patent law is subject to inconsistent and contradictory decisions concerning a fundamental issue of patent law. These ramifications can be no more apparent than in this case.

II. THE LACK OF A DETERMINATION BY THIS COURT OF WHETHER THE APPLICATION OF THE DOCTRINE OF EQUIVALENTS IS A TASK FOR THE JUDGE OR THE JURY IS CREATING UNCERTAINTY IN A FUNDAMENTAL AREA OF PATENT LAW.

This case came before the Federal Circuit on a motion for summary judgment of noninfringement which was erroneously granted for the second time by the District Court on the basis of prior art. The Federal Circuit, however, took it upon itself to affirm the District Court's decision by applying the all-elements rule, an issue which

was neither raised in the District Court as a basis for summary judgment, nor briefed by the parties for the appeal. The Federal Circuit held, "[T]he doctrine of equivalents may not legally cover the accused Cool Roller device." (9a). The Federal Circuit went on to hold, as a matter of law, that:

> [O]ne element of the...[Bradshaw] patent must be a handle support axle to which both a lifting handle and a pulling handle are attached. That element or limitation is entirely missing in the accused cooler and thus equivalent infringement fails under Pennwalt's all-elements or all-limitations rule. See Pennwalt, 833 F.2d at 935, 4 USPQ2d at 1740. (10a).

It is a well-settled principle that one-to-one correspondence between components of the accused device and the claimed invention is not required for a finding of equivalents. *Ethicon Endo-Surgery, Inc. v. United States Surgical Corp.*, 47 USPQ2d 1272, 1280 (Fed. Cir. 1998) citing *Sun Studs, Inc. v. ATA Equipment Leasing Inc.*, 872 F.2d 978, 989 (Fed. Cir. 1989), *overruled on other grounds*, and *A.C. Aukerman Co. v. R.L. Chaides Const. Co.*, 960 F.2d 1020, 1038-39 (Fed. Cir. 1992); See also *Dolly, Inc. v. Spalding & Evenflo Companies, Inc.*, 16 F.3d 394, 398 (Fed. Cir. 1994) citing *Intel Corp. v. U.S. International Trade Com'n*, 946 F.2d 821, 832 (Fed. Cir. 1991) and *Vaupel Textilmaschinen KG v. Meccanica Euro Italia S.P.A.*, 944 F.2d 870, 882 (Fed. Cir. 1991). It is possible for an accused device to infringe by equivalents even though two physical components of the accused device perform a function which is performed by a single element in the patented invention. *Ethicon*, 47 USPQ2d at 1280, and *Dolly*, 16 F.3d at 398, citing *Intel*, 946 F.2d at 832.

The Federal Circuit's application of the all-elements rule as a matter of law in this case directly contradicts the Federal Circuit's decision in *Ethicon*, a case decided less than three months prior to this case. In *Ethicon*, the Federal Circuit addressed its application of the all-elements rule in a series of recent cases. Referring specifically to the cases cited in the parties' briefs, the Federal Circuit stated:

> *Dolly*, *Weiner* (*v. NEC Electronics, Inc.*, 102 F.3d 534 (Fed. Cir. 1996)), and *Sage* (*Products, Inc. v. Devon Industries, Inc.*, 126 F.3d 1420 (Fed. Cir. 1997)) were decided on their facts, and were consistent with both our precedent and with the Supreme Court's recent express adherence to the doctrine of equivalents as a viable alternative to literal infringement. They simply explained that on the facts presented, no reasonable finder of fact could have found infringement by equivalents because the differences between the allegedly infringing devices and the claimed invention were plainly not insubstantial." *Ethicon*, 47 USPQ2d at 1278.

As in this case, the *Ethicon* case was before the Federal Circuit on appeal of a grant of summary judgment. The panel in *Ethicon* reviewed the factual findings made by the district court and concluded that, with respect to one of the patent claims, the grant of summary judgment was appropriate under the all-elements rule. *Id.* at 1279. In regard to the second claim of the patent at issue, the panel in *Ethicon* once again reviewed the factual findings of the district court. The panel noted that counsel for the alleged infringer acknowledged during oral argument that the physical difference between the accused product and the patent was very slight. *Id.* at 1280. The panel, therefore, held:

> Thus, we cannot say as a matter of law that this difference is substantial. It is a subtle difference in degree, not a clear, substantial difference or difference in kind....In light of this small difference...the Collins (the patentee's expert) declaration raises genuine issues of material fact as to equivalence, issues that must be resolved by the finder of fact. *Id.*

Accordingly, the grant of summary judgment of noninfringement under the doctrine of equivalents was reversed as to that claim and that portion of the case was remanded for the fact finder to determine whether the structures of the accused product and the patented product were equivalent. *Id.*

In contrast, at no point in its opinion did the panel in this case hold that no reasonable jury could find the differences between the handle axles on Igloo's Cool Roller products and the Bradshaw patent to be insubstantial. Instead, the panel improperly substituted itself in place of the fact finder and made a factual determination regarding equivalence when it held that an element of the Bradshaw patent was entirely missing in Igloo's Cool Roller products. In its decision in this case, the panel ignored all precedent granting the fact-finder the authority to determine, when an element or limitation of the patent is literally missing, whether a substitute element is present in the accused product which matches the function, way, and result of the element claimed in the patent, or whether the substitute element plays a role substantially different from the claimed element.

Ethicon and the cases cited therein unambiguously state that an analysis pursuant to the all-elements rule requires a determination, based on the specific facts of the case, of whether each element of the patented invention is

present in the accused product either literally or by its equivalent. Given this background, the panel in *Ethicon*, reviewed the district court's application of the all-elements rule under the standard of whether a reasonable jury could find equivalence. In this case, the panel itself made the determination regarding equivalence as a matter of law thereby removing such a determination from a reasonable jury.

These cases illustrate the uncertainty developing in this fundamental area of patent law. Depending upon the panel of the Federal Circuit hearing an appeal in a patent case on any given day, the patentee may be entitled to a determination of whether a reasonable jury could find equivalence or a determination by the panel itself, as a matter of law, of what constitutes equivalence. This is an untenable situation which will only be resolved when this Court determines whether the application of the doctrine of equivalents is a task to be performed solely by the jury.

III. SUFFICIENT EVIDENCE WAS PRESENTED IN THIS CASE FROM WHICH A JURY COULD MAKE A FINDING OF INFRINGEMENT UNDER THE DOCTRINE OF EQUIVALENTS.

Bradshaw provided ample evidence from which a reasonable fact finder could conclude that the elements of the Bradshaw patent not literally satisfied by Igloo's Cool Roller products are present by an equivalent, including the following:

(1) A stipulation from Igloo as to mechanical equivalents between the Bradshaw patent and the Cool Roller products;

(2) An uncontradicted affidavit from Bradshaw's expert, Dr. Crispin Hales, a mechanical engineer, containing: (a) an element-by-element comparison of the claims of the Bradshaw patent and the components of Igloo's Cool Roller products, and (b) a conclusion that there are either no or insubstantial differences between every element of the Bradshaw patent claims and the Cool Roller products;

(3) Deposition testimony from Igloo's President and Director of Engineering regarding the efforts taken by Igloo to maintain functional equivalence between its Cool Roller prototype and the Cool Roller products; and

(4) Affidavits from Igloo's customers stating they did not realize any changes had been made or that only insubstantial or cosmetic changes had been made between the prototype and the product received.

The Federal Circuit stated in *Sage* that the doctrine of equivalents protects a patent holder from infringement where only minor or insubstantial changes have been made from a claimed invention while retaining its essential functionality. *Sage*, 126 F.3d at 1424. It is difficult to imagine a less significant difference between a claimed device and an accused device. Plainly, the handle axles on Igloo's Cool Roller products retain the "essential functionality" of the single axle of the Bradshaw patent. Both configurations enable the lifting and pulling handle to be easily rotated about a handle axle enabling a user to easily and comfortably pull the portable cooler. A reasonable jury could find that the differences between Igloo's Cool Roller products and the Bradshaw patent are insubstantial. Therefore, it was beyond the power of the

Federal Circuit to determine, as a matter of law, that the two axle configuration on Igloo's Cool Roller products cannot be equivalent to the single axle configuration of the Bradshaw patent.

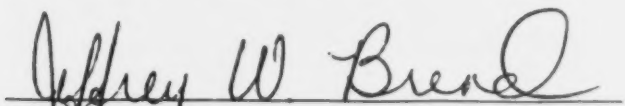
CONCLUSION

This Court has made clear that the essential inquiry under the doctrine of equivalents is whether the accused product contains elements identical or equivalent to each claimed element of the patented invention. What this Court has not made clear is whether such an inquiry is the task of the judge or the jury. Although a majority of the Federal Circuit has held that the inquiry under the doctrine of equivalents is a question of fact to be determined by the jury, Bradshaw was denied the right to such a jury determination under the guise of the all-elements rule being applied as a matter of law.

The all-elements rule simply requires a determination of whether every element or limitation of the patented invention or its equivalent is present in the accused device. See *Perkin-Elmer*, 822 F.2d 1528 (Fed. Cir. 1987), and *Pennwalt*, 833 F.2d 931 (Fed. Cir. 1987) (in banc). This is nothing more than what this Court has deemed to be the essential inquiry under the doctrine of equivalents. For the majority of the Federal Circuit to hold such an inquiry to be a matter of fact and for a panel of the Federal Circuit to hold, in essence, that such an inquiry is a matter of law, creates an untenable uncertainty regarding a fundamental issue of patent law.

WHEREFORE, for all the above reasons, the Petitioners request that this Petition for Writ of Certiorari be granted.

Respectfully submitted,



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NOTE: Pursuant to Fed. Cir. R. 47.6, this disposition is not citable as precedent. It is a public record. The disposition will appear in tables published periodically.

United States Court of Appeals for the Federal Circuit

98-1157

WILLIAM BRADSHAW and ROBERT SHEPHERD,
Plaintiffs-Appellants,

v.

IGLOO PRODUCTS CORPORATION,
Defendant-Appellee.

DECIDED: September 18, 1998

Before RICH, MICHEL, AND CLEVENGER, Circuit Judges.

MICHEL, Circuit Judge.

William Bradshaw and Robert Shepherd (hereinafter "Bradshaw") filed this appeal after the United States District Court for the Northern District of Illinois granted summary judgment in favor of Igloo Products Corporation ("Igloo"), concluding that, as a matter of law, Igloo's "Cool Roller," a portable drinks cooler, did not infringe Bradshaw's patent, United States Patent No. 4,873,841 (the "'841, patent") under the doctrine of

equivalents. See Bradshaw v. Igloo Prods. Corp., No. 94-C-6497 (Memorandum Opinion and Order Aug. 28, 1997). Although it incompletely applied our remand directions in Bradshaw v. Igloo Products Corp., 101 F.3d 716, 1996 WL 663310 (Fed. Cir. 1996) (Table), we conclude the district court nonetheless reached the legally correct result. Therefore, the district court's summary judgment of no equivalent infringement is affirmed.

BACKGROUND

On April 3, 1989, Bradshaw filed a patent application disclosing his portable drinks cooler on wheels. The application issued as the '841 patent on October 17, 1989, with three independent and twelve dependent claims. The first independent claim, claim 1, claims the basic cooler. Claims 6 and 11 each claim variations of this portable cooler, with different wheel-and-axle mounting configurations and the further requirement that one of the pair of lifting handles be located on the same side of the cooler as the wheels.

Bradshaw attempted to license the invention of the '841 patent to Igloo, one of the largest manufacturers of drinks coolers in the United States, but after several discussions Igloo decided not to enter a licensing agreement Bradshaw. Igloo later built a prototype of a new portable cooler, and commercially sold two coolers that, like the cooler claimed in Bradshaw's patent, included wheels and a pulling handle. These two cooler products were called the "Cool Roller," at issue in this appeal, and the "Rolling Kool Locker." Bradshaw filed suit in district court on October 28, 1994, alleging that Igloo's prototype and products infringed the '841 patent literally or under the doctrine of equivalents. Igloo's answer and counterclaim alleged, inter alia, that the '841

patent was invalid, but the district court issued no decision with respect to the patent's validity and thus that aspect of the case is not relevant to the appeal. Bradshaw also alleged that Igloo had infringed its trademark and violated Illinois trade practice law, but these allegations are not at issue in this appeal, and will not be discussed further.

Igloo filed a motion for summary judgment of no infringement. The district court, after concluding there was no genuine dispute of material fact precluding summary judgment, construed the three independent claims of the '841 patent to require two separate and distinct handles on the side of the cooler opposite the wheels -- one for pulling and one for lifting -- attached to the same handle support axle. See Bradshaw v. Igloo Products Corp., 912 F.Supp. 1088, 1098 (N.D. Ill. 1996). The court noted that this construction was supported by the drawings, which show two distinct handles attached to the same axle, and the written description. See id. Noting that the Rolling Kool Locker had only one handle on the side opposite the wheels which was used for both lifting and pulling, and that the Cool Roller used two separate axle attachments for the lifting and pulling handles on the side opposite the wheels, the district court concluded that Igloo's products did not literally infringe the '841 patent. See id. The court also concluded that the prototype cooler built by Igloo, which did make use of a separate lifting and pulling handle attached to a single axle, did not infringe the '841 patent because Igloo did not use, sell, or make for sale the prototype in violation of 35 U.S.C. § 271(a)(1994). See id. at 1101.

Bradshaw appealed the district court's summary judgment. This court affirmed the district court's decisions of no literal infringement and no infringement by the prototype. See Bradshaw, 1996 WL at **2-**3.

In reaching this decision, we affirmed the district court's claim construction, noting that:

> The patent consistently speaks of the lifting handles and the pulling handle as distinct elements. The claims so indicate..., the specification so indicates..., and the drawings so indicate. There is absolutely no suggestion anywhere in the patent that the claims refer to anything less than a total of three separate handles. Likewise, the patent is equally clear that the lifting handle and the pulling handle on the side of the cooler opposite the wheels are both coupled to the same attachment axle.

Id. at **2. This court vacated the ruling of noninfringement under the doctrine of equivalents, however, because of two legal errors committed by the district court: first, according to the panel, the court "erred when it considered only whether selected limitations of the claims were disclosed in the prior art and failed to consider the patented invention as a whole," when several of the other limitations in the claims might nonetheless have sufficed to confer patentability in light of the prior art; and second, the court failed to consider equivalency with respect to each of the two accused products, "thereby failing to consider that the scope of patent protection would have to be expanded beyond that afforded by the claims in two separate respects." Id. at **4. We therefore remanded the case to the district court with direction to reconsider potential infringement under the doctrine of equivalents, and specifically for a complete analysis under Wilson Sporting Goods Co. v. David Geoffrey & Assocs., 904 F.2d 677, 14 USPQ2d 1942 (Fed. Cir. 1990).

On remand, Igloo again moved for summary judgment of no infringement under the doctrine of equivalents. Bradshaw moved to strike the motion and requested other sanctions against Igloo based on alleged discovery violations. The court dismissed Bradshaw's motion, and that decision is not on appeal here. The district court then reconsidered whether the Cool Roller and the Rolling Kool Locker infringed the '841 patent under the doctrine of equivalents. In accordance with Wilson Sporting Goods, the district court drafted a hypothetical claim by easing certain limitations, thus creating a hypothetical claim broad enough to cover the Cool Roller. See Bradshaw, slip op. at 10-11, 13-14. The court then concluded that the prior art, specifically United States Patent No. 4,846,493 (the "Mason patent"), made this hypothetical claim unpatentable because the redrafted elements -- namely, a pulling and a lifting handle attached to the same side of the cooler but to separate and distinct handle support structures -- were specifically disclosed therein. See id. It concluded, therefore, that "[t]he prior art of the Mason patent prohibits [Bradshaw] from showing that the Cool Roller infringes the '841 patent under the doctrine of equivalents." Id. at 14. Thus, the district court granted Igloo's motion for summary judgment as to the Cool Roller. See id. at 17. With respect to the Rolling Kool Locker, however, the district court concluded there was a genuine factual dispute regarding whether two separate handles are equivalent to one handle used for both pulling and lifting, and thus denied summary judgment respecting that product. See id. at 16-17.

After the district court issued its decision, Bradshaw filed a motion to dismiss voluntarily its infringement claim as to the Rolling Kool Locker. The district court granted the motion, and entered judgment

regarding the Cool Roller. See Bradshaw v. Igloo Prods. Corp., No 94-C-6497 (Order Dec. 2, 1997). Bradshaw then appealed from the summary judgment of noninfringement with respect to the Cool Roller, arguing that the district court misapplied the law of Wilson Sporting Goods in determining that the '841 patent was not entitled to a scope of equivalents that include the Cool Roller, and that if the district court had properly applied the Wilson Sporting Goods test, material facts were sufficiently in dispute regarding the equivalency of the relevant features of the accused device such that summary judgment was improper. We have jurisdiction to consider this appeal under 28 U.S.C. § 1295(a)(1) (1994). Oral argument was heard on August 7, 1998.

DISCUSSION

The doctrine of equivalents allows a patentee to exercise the right to exclude devices that do not literally meet the limitations of the claims of the patent but differ only insubstantially from the claimed invention, for example, because they have substantially the same function, way, and result. See Perkin-Elmer Corp. v. Westinghouse Elec. Corp., 822 F.2d 1528, 1533, 3 USPQ2d 1321, 1325 (Fed. Cir. 1987) ("To be a 'substantial equivalent,' the element substituted in the accused device for the element set forth in the claim must not be such as would substantially change the way in which the function of the claimed invention is performed."); see also Graver Tank & Mfg. Co. v Linde Air Prods. Co., 339 U.S. 605, 608 (1950) (holding that an insubstantial change is shown if a patentee demonstrates that the accused product performs substantially the same function in substantially the same way to produce substantially the same result as the patented invention).

Although what constitutes infringement under the doctrine of equivalents is a question of fact, often amenable to a jury trial, see, e.g., Perkin-Elmer, 822 F.2d at 1531, 3 USPQ2d at 1323 ("[i]n sum, a determination of nonequivalence is a finding of fact"), there are several limits on the range of equivalents legally available. For example, an accused device cannot equivalently infringe a patent claim unless every limitation, or its equivalent, is found in that device; this is known as the "all elements" or "all limitations" rule. See Warner-Jenkinson Co. v. Hilton Davis Chem. Co., 520 U.S. 17, ---, 117 S. Ct. 1040, 1054 (1997) (noting that the essential inquiry under the doctrine of equivalents is "[d]oes the accused product or process contain elements identical or equivalent to each claimed element of the patented invention," and holding that "[t]he determination of equivalence should be applied as an objective inquiry on an element-by-element basis"); Ethicon Endo-Surgery Inc. v. United States Surgical Corp., --- F.3d ---, ---, --- n.*, 47 USPQ2d 1272, 1276, 1277 n.* (Fed. Cir. 1998); Pennwalt Corp. v. Durand-Wayland, Inc., 833 F.2d 931, 935, 4 USPQ2d 1737, 1740 (Fed. Cir. 1987) (in banc). Similarly, a patentee may not rely on the doctrine of equivalents to obtain protection against infringement by subject matter that it could not have patented; the scope of protection available under the doctrine of equivalents is thus limited by the prior art. See Wilson Sporting Goods, 904 F.2d at 684. Where an accused device cannot infringe under the doctrine of equivalents because of the application of one of these legal bars, summary judgment of non-infringement is appropriate.

I.

Bradshaw's strongest argument on appeal is that, despite our remand order, the district court still failed to apply correctly Wilson Sporting Goods to the hypothetical claim which the court drafted to cover the Cool Roller. As we explained in Wilson Sporting Goods:

> Whether prior art restricts the range of equivalents of what is literally claimed can be a difficult question to answer. To simplify analysis and bring the issue onto familiar turf, it may be helpful to conceptualize the limitation on the scope of equivalents by visualizing a hypothetical patent claim, sufficient in scope to literally cover the accused product. The pertinent question then becomes whether that hypothetical claim could have been allowed by the PTO over the prior art. If not, then it would be improper to permit the patentee to obtain that coverage in an infringement suit under the doctrine of equivalents.

904 F.2d at 684, 14 USPQ2d at 1948 (final emphasis added). As we have clarified in several subsequent cases, including our remand decision in this case, a district court must consider the hypothetical claim not by focusing on its individual elements but as a whole to determine whether the device, if so claimed, would have been obvious over the prior art. See Bradshaw, 1996 WL at **4 ("While the location of the handles is the only element involved in the present dispute regarding infringement by equivalents, it is not the only limitation within the asserted claims....It is conceivable that any one of these limitations, alone or in combination with the other limitations, may have been sufficient to confer

patentability, and the district court erred when it failed to address this possibility in its analysis.").

The district court here failed to consider the hypothetical claim as a whole, but focused instead only on the two handles mounted proximately but on separate axles on the same side of the Cool Roller and the disclosure of exactly such structures in the Mason patent. Finding this disclosure in the prior art, the district court concluded that the legally available range of equivalents could not encompass the accused device because this necessarily broader claim limitation would itself have been obvious in light of the Mason patent.

Although we could remand this case once again to the district court with even more precise instructions regarding the application of the hypothetical claim test, this would not be an economic use of judicial resources, guarantee a final result for the parties who have been involved in this litigation for several years at great expense, or even avoid future additional appeals to this court.

II.

We are convinced that, despite its erroneous analysis, the district court here did reach the correct result, for the doctrine of equivalents may not legally cover the accused Cool Roller device. We are not bound to the analytical framework relied on by the district court, and are free to review the district court's decision applying an alternative rule of law. See Koyo Seiko Co. v. United States, 95 F.3d 1094, 1099 (Fed. Cir. 1996) (quoting SEC v. Chenery Corp., 381 U.S. 80 (1943)); Filmtec Corp. v. Hydranautics, 67 F.3d 931, 937, 36 USPQ2d 1410, 1413 (Fed. Cir. 1995).

As we held in Bradshaw's previous appeal to this court, the patent is extremely clear that the pulling handle and the nearby lifting handle are both attached to the same axle. See Bradshaw, 1996 WL at **2. Specifically, our examination of claim 1 of the '841 patent reveals that Bradshaw disclosed a "pulling handle coupled to one of the handle support axles." There can be no doubt, then, that the pulling handle and one lifting handle must be attached to the same handle support axle. The language of claims 6 and 11 is equally precise. Moreover, the specification makes repeated reference to the fact that the pulling handle is attached to the same handle support axle as one of the lifting handles. See, e.g., '841 pat., col. 1, ll. 31032; col. 2, ll. 63-64; col. 3, ll. 1-3. Thus, one element of the '841 patent must be a handle support axle to which both a lifting handle and a pulling handle are attached. That element or limitation is entirely missing in the accused cooler and thus equivalent infringement fails under Pennwalt's all-elements or all-limitations rule. See Pennwalt, 833 F.2d at 935, 4 USPQ2d at 1740.

AFFIRMED.

United States Court of Appeals for the Federal Circuit

ORDER

A combined petition for rehearing and suggestion for rehearing in banc having been filed by the APPELLANT, and the petition for rehearing having been referred to the panel that heard the appeal, and thereafter the suggestion for rehearing in banc having been referred to the circuit judges who are in regular active service,

UPON CONSIDERATION THEREOF, it is

ORDERED that the petition for rehearing be, and the same hereby is, DENIED and it is further

ORDERED that the suggestion for rehearing in banc be, and the same hereby is, DECLINED.

The mandate of the court will issue on November 4, 1998.

FOR THE COURT,

/s./ Jan Horbaly

Jan Horbaly
Clerk

Dated: October 28, 1998

FILED
U.S. COURT OF APPEALS FOR
THE FEDERAL CIRCUIT

OCT 28 1998

JAN HORBALY
CLERK

cc: JEFFREY W. BREND
RICHARD G. LIONE

BRADSHAW V IGLOO PRODUCTS, 98-1157
(DCT - 94-CV-6497)

****
* *
* Note: Pursuant to Fed. Cir. R. *
* 47.6, this order is not citable as *
* precedent. It is a public record. *
* *
****

Supreme Court, U.S.

No. 98-1244 JAN 26 1999

OFFICE OF THE CLERK

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM 1998

WILLIAM BRADSHAW and ROBERT SHEPHERD,
Petitioners,

v.

IGLOO PRODUCTS CORPORATION,
Respondent.

On Petition For Writ Of Certiorari
To The United States Court Of Appeals
For The Federal Circuit

SUPPLEMENTAL APPENDIX TO THE PETITION FOR WRIT OF CERTIORARI

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IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION

WILLIAM BRADSHAW and ROBERT SHEPHERD,	)	
Plaintiffs, Counter-defendants,	)	
v.	)	No. 94 C 6497
IGLOO PRODUCTS CORPORATION,	)	
Defendant, Counter-claimant.	)	

MEMORANDUM OPINION AND ORDER

After hurting his back carrying a ice chest, plaintiff Robert Shepard wondered why he had never seen a cooler with wheels on the market. Ultimately, Shepard and plaintiff, William Bradshaw obtained U.S. Patent No. 4,873,841 (the "'841 patent") covering such an invention. On October 28, 1994, plaintiffs sued defendant Igloo Products Corp. ("Igloo") claiming that, inter alia, two of Igloo's coolers, the Cool Roller and the Rolling Kool Locker, infringed the '841 patent. Presently pending is Igloo's renewed motion for summary judgment and plaintiffs' motion to strike Igloo's motion for summary judgment and for other sanctions.

I. BACKGROUND

The '841 patent describes the invention as a portable cooler having a pair of wheels at one end of the cooler and an adjustable handle on the end opposite the wheels for pulling the cooler. The invention further describes lifting handles on opposite ends of the cooler. The pulling handle and one of the lifting handles are coupled to the same support axle. The specific language of claims 1, 6, and 11 of the '841 patent is set forth in the earlier decision in this case, Bradshaw v. Igloo Products Corp., 912 F. Supp. 1088 (N.D. Ill. 1996) ("Igloo I"), and need not be repeated here.

Igloo manufactures and sells two models of coolers, the Rolling Kool Locker and the Cool Roller, both of which plaintiffs allege infringe the '841 patent. The Rolling Kool Locker "has a rotatable lifting handle located on each end of the storage container compartment," but it does not have a separate lifting handle. Instead, one of the lifting handles is used to pull the cooler. The Cool Roller has separate lifting and pulling handles, although these handles are coupled to separate support axles.

On September 22, 1995, Igloo moved for summary judgment on the basis of noninfringement of claims 1, 6 and 11 of the '841 patent. Summary judgment was granted in Igloo's favor in a memorandum opinion and order dated January 5, 1996. Igloo I, 912 F. Supp. at 1101. Plaintiffs appealed that decision to the Federal Circuit.

The Federal Circuit affirmed the decision in part and vacated it in part and remanded the case back to this court. Bradshaw v. Igloo Products Corp., 101 F.3d 716 (Fed. Cir. 1996) (Table) ("Igloo II"). The Federal Circuit agreed with Igloo I's determination that there was no literal infringement by Igloo's products, but found error in the portion of the opinion addressing infringement under the doctrine of equivalents. Igloo has filed a renewed motion for summary

judgment. Based on supporting materials submitted by Igloo in connection with its motion, plaintiffs move to strike Igloo's motion for summery judgment.

II. PLAINTIFFS' MOTION TO STRIKE IGLOO'S MOTION FOR SUMMARY JUDGMENT

Plaintiffs move to strike Igloo's renewed motion for summary judgment,[1] claiming that Igloo "sandbagged" plaintiffs by supporting its renewed motion with witnesses, statements, photographs and drawings not previously disclosed to them. Plaintiffs note that at a hearing on June 23, 1995, Igloo's attorney represented that, "They [plaintiffs] have all the documents. They have all our documents." Plaintiffs state that they did not find out about the additional witnesses and documents until January 10, 1997, when Igloo filed its renewed motion for summary judgment. In plaintiffs' view, Igloo should have produced: (i) photographs of garbage cans manufactured by Toter, Inc. (cited by Igloo as prior art); (ii) drawings and photographs of garbage cans manufactured by Gott Corp. (also cited as prior art); (iii) the affidavit of the chief executive officer of Toter; and (iv) the affidavit of one of Igloo's attorneys.

In response, Igloo explains that its evidence of prior art was not discovered until December 19, 1996, when Igloo's counsel, Richard Lione, contacted Frederick Schmidt, Director of Engineering at Igloo, and asked him whether he was familiar with any wheeled trash containers manufactured prior to 1998. Schmidt related that Gott manufactured such

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[1] In full, plaintiffs request that "this Court strike Defendant Igloo's 'Renewed Motion for Summary Judgment' and Supplemental Rule 12(M) Statement of Material Facts, in whole or in part; to hold the Defendant in default, or for other appropriate sanctions."

a container. Lione subsequently received a copy of 1986 catalogue pages displaying the containers from Gott. On January 7, 1997, Lione spoke to co-counsel, J. Ray Riley, about the catalog. Riley told Lione that he thought containers in the alley outside his office were also wheeled. Riley photographed the garbage cans, discovered to be manufactured by Toter, Inc. A paralegal in Lione's office contacted the chief executive officer of Toter and obtained his affidavit relating to the containers. In addition, Lione states that he photographed additional Toter garbage cans, distributed by the City of Chicago, in the alley behind his residence.

Plaintiffs' counsel did not contact Igloo's counsel prior to filing its motion, nor have plaintiffs filed a memorandum disputing any of the facts as Igloo relates them. Igloo's version of the facts will be accepted. None of the evidence cited by plaintiffs violates discovery obligations of Igloo. Igloo was not prohibited from continuing its investigation into prior art subsequent to the Federal Circuit's decision in this case. At the most, plaintiffs received Igloo's evidence three weeks after it was obtained. As to some of the evidence, plaintiffs received it as little as three days after it was obtained. These time periods are not unreasonable. This motion could have been avoided had plaintiffs investigated the reason for the late turnover of evidence. Plaintiffs' motion will be denied.

III. RENEWED MOTION FOR SUMMARY JUDGMENT

Igloo argues that it is entitled to summary judgment because prior art limits any expansion of claims of the '841 patent to cover its products under the doctrine of equivalents. Igloo's argument must be viewed under the standards set forth by The Federal Circuit in Igloo II. In

Igloo II, the Federal Circuit found error because the doctrine of equivalents analysis in Igloo I had:

> considered only whether selected limitations of the claims were disclosed in the prior art and failed to consider the patented invention as a whole.

Igloo II, 101 F.3d at *4. Second, the Federal Circuit stated that each of Igloo's products should have been considered on an individual basis. The Federal Circuit explained that Igloo I's analysis

> fail[ed] to consider that the scope of patent protection would have to be expanded beyond that afforded by the claims in two separate respects depending on the product alleged to infringe. Namely, the scope of the right to exclude would have to extend to pulling handles attached on two separate axles to cover the Cool Roller and it would have to extend to a combined lifting and pulling handle to cover the Rolling Kool Locker.

Nonetheless, the Federal Circuit concluded that "summary judgment of non-infringement may still be appropriate in this case after a proper analysis of the prior art." Id.

Since the Federal Circuit issued its decision in Igloo II, the Supreme Court has affirmed the viability and clarified the scope of the doctrine of equivalents under the 1952 revision of the Patent Act, 35 U.S.C. § 100 et seq. Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co., 117 S. Ct. 1040 (1997). The Supreme Court stated, however, that it "shared the concern of the dissenters below that the doctrine of equivalents...has taken on a life of its own, unbounded by patent claims." Id. at 1048. The Court cited approvingly the dissent of Judge Nies in reconciling the

doctrine of equivalents with the definitional and public notice functions of the statutory claiming requirement:

> "[A] distinction can be drawn that is not too esoteric between substitution of an equivalent or a component in an invention and enlarging the metes and bounds of the invention beyond what is claimed.
>
> . . . . .
>
> Where a claim to an invention is expressed as a combination of elements, as here, 'equivalents' in the sobriquet 'Doctrine of Equivalents' refers to the equivalency of an element or part of the invention with one that is substituted in the accused product or process.
>
> . . . . .
>
> This view that the accused device or process must be more than 'equivalent' overall reconciles the Supreme Court's position on infringement by equivalents with its concurrent statements that 'the courts have no right to enlarge a patent beyond the scope of its claims as allowed by the Patent Office.' [Citations omitted.] The 'scope' is not enlarged if courts do not go beyond the substitution of equivalent elements."

Id. at 1049 (citing Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co., 62 F.3d 1512, 1573-74 (Fed. Cir. 1995) (Nies, J., dissenting)) (emphasis in original). In other words, showing overall equivalency of the patented product against the accused product will not be sufficient to prove infringement.

> Each element contained in a patent claim is deemed material to defining the scope of the patented invention, and thus the doctrine of equivalents must

> be applied to individual elements of the claim, not to the invention as a whole.

Id. Thus, the analysis of the Cool Roller and the Rolling Kool Locker will be examined on a element by element basis, rather than determining whether Igloo's products are equivalent overall to plaintiffs' invention.

A. Effect of Hilton Davis on Prior Art Limitations to the Doctrine of Equivalents

In opposition to summary judgment, plaintiffs contend that the Supreme Court decision in Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co. changes Federal Circuit law relating to the doctrine of equivalents. According to plaintiffs, Hilton Davis holds that the only relevant inquiry under the doctrine of equivalents is the jury question of whether the accused product contains identical or equivalent elements to each claimed element of the patented invention. Plaintiffs argue that the prosecution history and prior art are irrelevant if substantial identity is shown. Finally, plaintiffs assert that:

> Hilton teaches that the rule against claim enlargement or expansion is no longer relevant to this Court's inquiry under the doctrine of equivalents.

Thus, plaintiffs argue that the Federal Circuit in Igloo II incorrectly directed this court to decide irrelevant issues.

Plaintiffs' argument that the judge has no role in assessing whether prior art limits the range of equivalency for a claim does not find support in Hilton Davis. In Hilton Davis, the Supreme Court noted the role of the judge in the pretrial process:

> Of course, the various legal limitations on the application of the doctrine of equivalents are to be determined by the court, either on a pretrial motion for partial summary judgment or on a motion for judgment as a matter of law at the close of the evidence and after the jury verdict. Fed. Rule Civ. P. 56; Fed. Rule Civ. Proc. 50. Thus, under the particular facts of a case, if prosecution history estoppel would apply or if a theory of equivalence would entirely vitiate a particular claim element, partial or complete judgment should be rendered by the court, as there would be no further material issue for the jury to resolve.

Id. at 1053 n.8. Thus, plaintiffs' assertion that all issues relating to the doctrine of equivalents are for the jury is overbroad. At a minimum, it will be assumed that Wilson Sporting Goods Co. v. David Geoffrey & Associates, 904 F.2d 677 (Fed. Cir. 1990) was not implicitly overruled by Hilton Davis. In Wilson Sporting Goods, the Federal Circuit held that "a patentee should not be able to obtain, under the doctrine of equivalents, coverage which he could not lawfully have obtained from the PTO by literal claims." Id. at 684. Because prior art limits what an inventor could have claimed, prior art also limits the range of permissible equivalents of a claim. Id. The Federal Circuit provided guidance as to the prior art analysis:

> Whether prior art restricts the range of equivalents of what is literally claimed can be a difficult question to answer. To simplify analysis and bring the issue onto familiar turf, it may be helpful to conceptualize the limitation on the scope of equivalents by visualizing a hypothetical patent claim, sufficient in scope to literally cover the

accused product. The pertinent question then becomes whether that hypothetical claim could have been allowed by the PTO over the prior art. If not, then it would be improper to permit the patentee to obtain that coverage in an infringement suit under the doctrine of equivalents. If the hypothetical claim could have been allowed, then prior art is not a bar to infringement under the doctrine of equivalents.

Id. This analysis will be applied in the instant case.

B. Doctrine of Equivalents

In Igloo II, the Federal Circuit directed that the doctrine of equivalents analysis be applied to the Cool Roller and the Rolling Kool Locker individually. Igloo concedes, at least for purposes of this motion, that the elements of claims 1, 6 and 11 addressing the wheel and axle configuration need no expansion to cover the Cool Roller and Rolling Kool Locker.

1. Cool Roller

The Cool Roller differs from the '841 patent in that the lifting and pulling handles (on the side opposite the wheels) are attached to separate axles whereas the '841 patent provides that the lifting and pulling handles are attached to the same axle. Element (e) of claim 1 claims "a pair of handle support structures coupled to opposite sides of the cooler compartment, each support structure having a handle support axle." Expanded to encompass the Cool Roller, element (e) would allow for more than "a pair" of handle support structures on the cooler since the Cool Roller

has three handle support structures. The Mason patent,[2] however, describes a wheeled cooler with one pulling and two lifting handles, each on separate axles. Element (e) of claim 1 is covered by prior art. In addition, element (f) of claim 6 and element (f) of claim 11 contain the same language as element (e) of claim 1, except that these elements state that the handle structures are positioned on the side of the cooler adjacent to the wheels. These elements, expanded by allowing more than a pair of handle support structures, are also covered by the Mason patent.

Plaintiffs contend that the Mason patent is not prior art because Mason post-dates the conception of the '841 patent. Plaintiffs assert that Bradshaw conceived of the invention over Labor Day weekend in 1987 and rendered drawings of the invention the next week. Plaintiffs, however, do not submit these drawings to support their contention, and Bradshaw testified at his deposition that he is not sure whether the sketches exist. Plaintiffs built

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[2] The Mason patent is described in Igloo I as follows:

> The "Mason" patent (United States Patent No. 4,846,493), filed in 1987, is a two-wheel cooler, but its wheels are on hinges that fold down for pulling and fold up so the cooler can lay flat. Its pulling handle is on the side opposite the wheels and has a hinge so that it can be folded in half. When unfolded, the pulling handle is long enough to permit pulling the handle without stooping. It is indicated that the pulling handle is attached below the lifting handle, but its exact location is not specified. Drawings show the pulling handle attached above the middle of the cooler's side.

Igloo I, 912 F. Supp. at 1099.

prototypes of their invention in the spring of 1988 and filed their patent application on April 3, 1989. The application for the Mason patent was filed on October 26, 1987. In other words, the Mason application post-dates the date of conception of the '841 patent if the alleged date that drawings were rendered applies, but it pre-dates the '841 patent if the alleged date the prototypes were built applies.

The first party to reduce an invention to practice possesses priority "unless the other party can show that it was the first to conceive the invention and that it exercised reasonable diligence in later reducing that invention to practice." Price v. Symsek, 988 F.2d 1187, 1190 (Fed. Cir. 1993). Conception is "the formation in the mind of the inventor, of a definite and permanent idea of the complete and operative invention, as it is hereafter to be applied in practice." FilmTec Corp. v. Hydranautics, 982 F.2d 1546, 1551 (Fed. Cir. 1992). Priority is a question of law determined by the underlying factual circumstances. Price, 988 F.2d at 1190. An inventor's testimony concerning priority cannot, standing alone, demonstrate priority over another patentee's rights. Id. at 1194. The inventor's testimony must be supported by some sort of corroborating evidence. Id.

Under these standards, the Mason patent is prior art. Plaintiffs have not presented any evidence other than their own testimony that the invention possesses priority over the Mason patent. Even if an inventor's testimony was sufficient to demonstrate priority, Bradshaw's testimony does not rise to the level of "conception" as defined by the Federal Circuit. Bradshaw's statement that he had an idea for a cooler with wheels is not a "definite and permanent idea of the complete and operative invention." Similarly, plaintiffs do not elaborate as to what Bradshaw's alleged drawings detailed; Bradshaw does not even state whether his sketches depicted pulling or lifting handles. As of

September 1987, the simple concept of a cooler with wheels was covered by the Bartholomew patent,[3] which was filed on December 11, 1986. Nothing in Bradshaw's testimony indicates that the idea he came up with over Labor Day weekend in 1987 is distinguishable from the Bartholomew patent. Conception of the '841 patent did not occur until the spring of 1988, when the prototype was created and after the Mason patent application had been filed. The Mason patent, therefore, is relevant prior art, which prevents expansion of element (e) to cover the Cool Roller.

The Mason patent also limits expansion of other elements. Element (f) of claim 1 (and element (g) of claims 6 and 11) claims "a lifting handle coupled to the handle support axle of each handle support structure enabling the cooler to be easily lifted to and from a vehicle." Expanded to fit the Cool Roller, element (f) would claim "each lifting handle coupled to a handle support structure. . . ." Again the Mason patent shows a cooler with two lifting handles, each coupled to a handle support axle.

Element (g) (and element (h) of claims 6 and 11) claims:

> a pulling handle coupled to one of the handle support axles wherein said pulling handle being easily rotated about the handle axle enabling a user to easily and comfortably pull the portable cooler.

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[3] Igloo I described the Bartholomew patent as follows:

> The 1988 "Bartholomew" patent (United States Patent No. 4,724,681) is a two-wheel cooler that is pulled, but its wheels are on the short side and the pulling handle, which folds in two places, is on the same side as the wheels.

Igloo I, 912 F. Supp. at 1099.

Expanded element (g) would claim a "pulling handle coupled to a handle support handle wherein said pulling handle being easily rotated about the handle axle . . ." The Mason patent similarly shows a pulling handle that rotates about an axle. The handle described in the Mason patent is extendable, but the particular claim states that the cooler has "means connected to said cooler for pulling the same when the wheels are in the operable position." Thus, the Mason patent covers the Cool Roller's pulling handle and plaintiff could not have claimed an invention broad enough to include the handle configuration of the Cool Roller. The prior art of the Mason patent prohibits plaintiffs from showing that the Cool Roller infringes the '841 patent under the doctrine of equivalents

2. Rolling Kool Locker

As to the Rolling Kool Locker, Igloo contends that the elements of hypothetically expanded Claims 1, 6 and 11 are present in the prior art of the Mason and Bartholomew patents. The Rolling Kool Locker utilizes a single handle functioning as both a lifting and pulling handle, whereas the '841 patent describes a cooler with separate lifting and pulling handles, both "coupled" to the same axis. Elements (e), (f) and (g) of claim 1 describe this feature.

Element (e)[4] of claim 1 claims "a pair of handle support structures coupled to opposite sides of the cooler compartment, each support structure having a handle support axle." This claim needs no expansion to cover the Rolling Cool Locker. Elements (f) and (g)[5] of claim 1 describe two

---

[4] This analysis also applies to element (f) of claims 6 and 11.

[5] This analysis also applies to elements (g) and (h) of claims 6 and 11.

different handles, the lifting handle and the pulling handle. Hypothetically expanded elements (f) and (g) would state as follows:

> a lifting handle coupled to the handle support axle of each handle support structure enabling the cooler to be easily lifted to and from a vehicle;
>
> a pulling handle, which may be either the same handle as the lifting handle or a separate handle, coupled to the handle support axle wherein said handle being easily rotated about the handle axle enabling a user to easily and comfortably pull the cooler

The question, then, is as the Federal Circuit posed it: does the scope of plaintiffs' right to exclude extend to a combined lifting and pulling handle to cover the Rolling Kool Locker, or would such a configuration ensnare prior art?

Igloo contends that the Mason patent constitutes prior art which limits the expansion of the claims of the '841 patent to cover the Rolling Kool Locker's handle configuration. But the Mason patent describes separate axles for the lifting and pulling handles, whereas under either the actual or expanded language of the '841 patent utilize a single axle. Igloo asserts that the relevant question is "would it have been obvious . . . to take a conventional cooler and mount it on a wheel/axle assembly fixed under one end of the cooler compartment?" In light of the Federal Circuit's direction, however, this question is too narrow. Certainly it was obvious to attach a pulling handle (or separate pulling and lifting handles) to the side of the cooler opposite the wheels, e.g., the Mason patent. The Federal Circuit, however, directed this court to consider whether the

'841 patent could extend to a combined pulling and lifting handle. Igloo has not pointed to any prior art describing a pulling and lifting handle (or handles) attached to a single axle. Although the cooler described in the '841 patent utilizes separate handles for pulling and lifting, the question of whether the two handles are equivalent to one combined pulling and lifting handle is one for the jury.[6]

IT IS THEREFORE ORDERED that:

(1) Motion of plaintiffs Robert Shepard and William Bradshaw to strike and for other sanctions [82] is denied.

(2) Renewed motion of igloo Products Corp. for summary judgment [77-1] is granted in part and denied in part. The motion is granted as to Igloo's Cool Roller product. The motion is denied as to Igloo's Rolling Kool Locker product.

(3) The parties are directed to submit a final pretrial order in accordance with Local Rule 5.00 in open court at 9:15 a.m. on October 21, 1997.

ENTER:

/s/ William T. Hart
UNITED STATES DISTRICT JUDGE

DATED: AUGUST /s/ 28, 1997

---

[6] It should be noted that this opinion does not restrict Igloo from submitting to a jury a general instruction on obviousness, which would allow the jury to consider not only the scope and content of the prior art, but also the level of ordinary skill in the art as well as other factors.

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION

William Bradshaw and Robert Shepherd	)	
Plaintiffs,	)	
V.	)	No. 94 C 6497
Igloo Products Corp.	)	
Defendant.	)	

ORDER

This cause coming to be heard on Plaintiffs' Motion to Voluntarily Dismiss Claims with respect to Kool Locker a/k/a Rolling Kool Locker and for Entry of a Final Order with respect to the Cool Roller Product, the parties stipulating to the Order, the parties appearing by their respective attorneys, the court having jurisdiction and the court being fully advised in the premises,

IT IS HEREBY ORDERED that Plaintiffs' Motion to Voluntarily Dismiss Claims with respect to Kool Locker a/k/a Rolling Kool Locker and for Entry of a Final Order with respect to Cool Roller Product is granted. The Clerk of the Court is directed to dismiss without prejudice all claims in the Complaint with respect to the Kool Locker a/k/a Rolling Kool Locker products. The Court finding there is no just reason for delay, the Clerk of the Court is further directed to enter a final and appealable judgment to all claims in the Complaint against Plaintiff with respect to the Cool Roller products. The Clerk of the Court is further directed to enter judgment dismissing

Defendant-Counterplaintiff's counterclaim cause of action without prejudice for lack of subject matter jurisdiction. Each party shall pay their own costs.

Stipulated to by:

/s/ Jeffrey W. Brend
Attorney for Plaintiff

/s/ Richard G. Lione
Attorney for Defendant

Enter:

/s/ William T. Hart
UNITED STATES DISTRICT JUDGE

Dated: /s/ 12-2-97

AO 450(Rev. 5/85)Judgment in a Civil Case

United States District Court
Northern District of Illinois
Eastern Division

F I L E D
/s/ COPY
DEC 2 1997

WILLIAM T. HART, JUDGE
UNITED STATES DISTRICT COURT

William Bradshaw, et al.

JUDGMENT IN A CIVIL CASE

V.

Case Number: 94 C 6497

Igloo Products Corp.

□ Jury Verdict. This action came before the Court for a trial by jury. The issues have been tried and the jury rendered its verdict.

■ Decision by Court. This action came to hearing before the Court. The issues have been heard and a decision has been rendered.

IT IS ORDERED AND ADJUDGED that all claims in the complaint with respect to the Kool Locker a/k/a Rolling Kool Locker products are dismissed without prejudice. Court finding there is no just reason for delay enters a final and appealable judgment to all claims in the complaint against plaintiff with respect to the Cool Roller products. Judgment is further entered dismissing defendant-counterplaintiff's counterclaim cause of action

without prejudice for lack of subject matter jurisdiction. Each party shall pay their own costs.

Michael W. Dobbins, Clerk of Court

Date: 12/2/97

/s/ William J. Stasiek
William J. Stasiek, Deputy Clerk

United States Court of Appeals for the Federal Circuit

98-1157

WILLIAM BRADSHAW and ROBERT SHEPHERD,

Plaintiffs-Appellants,

v.

IGLOO PRODUCTS CORPORATION,

Defendant-Appellee.

ORDER

A combined petition for rehearing and suggestion for rehearing in banc having been filed by the APPELLANT, and the petition for rehearing having been referred to the panel that heard the appeal, and thereafter the suggestion for rehearing in banc having been referred to the circuit judges who are in regular active service,

UPON CONSIDERATION THEREOF, it is

ORDERED that the petition for rehearing be, and the same hereby is, DENIED and it is further

ORDERED that the suggestion for rehearing in banc be, and the same hereby is, DECLINED.

The mandate of the court will issue on November 4, 1998.

FOR THE COURT,

/s./ Jan Horbaly

Jan Horbaly
Clerk

Dated: October 28, 1998

FILED
U.S. COURT OF APPEALS FOR
THE FEDERAL CIRCUIT

OCT 28 1998

JAN HORBALY
CLERK

cc: JEFFREY W. BREND
RICHARD G. LIONE

BRADSHAW V IGLOO PRODUCTS, 98-1157
(DCT - 94-CV-6497)

****
* *
* Note: Pursuant to Fed. Cir. R. *
* 47.6, this order is not citable as *
* precedent. It is a public record. *
* *
****

Supreme Court, U.S.
FILED
MAR 5 1999
CLERK

No. 98-1244

In The

Supreme Court of the United States

October Term, 1998

WILLIAM BRADSHAW and ROBERT SHEPHERD,

Petitioners,

v.

IGLOO PRODUCTS CORPORATION,

Respondent.

On Petition For Writ Of Certiorari
To The United States Court Of Appeals
For The Federal Circuit

RESPONDENT'S BRIEF IN OPPOSITION

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LIST OF PARTIES AND PARENT COMPANIES

William Bradshaw

Robert Shepherd

Igloo Products Corporation

Brunswick Corporation,
the parent of Igloo Products Corporation

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STATEMENT OF THE CASE

A portable cooler on wheels, with lifting handles and a pulling handle coupled to the cooler by separate support axles, was not new when the petitioners, William Bradshaw and Robert Shepherd (hereinafter collectively "Bradshaw"), made the invention which became the subject matter of U.S. Patent No. 4,873,841 (hereinafter the "Bradshaw patent"). The prior art Mason U.S. Patent No. 4,846,493 illustrated and described precisely such a construction, as shown in FIGURE 4 of the drawings from the Mason patent, reproduced at page 1 of the Appendix to this Response.

The Bradshaw patent application was filed with fifteen claims which differed from the prior art only in that they literally required that both a lifting handle and a separate pulling handle be coupled to the same handle support axle on the end of the cooler opposite the wheels, as shown in FIGURE 1 of the drawings from the Bradshaw patent, reproduced at page 2 of the Appendix to this Response. The Bradshaw patent issued with those fifteen specifically limited claims.

In 1994 the respondent, Igloo Products Corporation (hereinafter "Igloo"), began manufacturing and selling a portable cooler which it called the Cool Roller. The Cool Roller product has a lifting handle and a separate pulling handle which are, like the Mason patent construction, coupled to separate handle support axles on the end of the cooler opposite a pair of wheels. Igloo designed its wheeled cooler with a lifting handle and a separate pulling handle attached to separate handle axles specifically to avoid the claims of the Bradshaw patent.

Bradshaw acknowledges that the patent claims do not literally cover the Igloo Cool Roller product. However, in an infringement action against Igloo, Bradshaw contended that the Cool Roller product infringes under the Doctrine of Equivalents.

In a motion for summary judgment of non-infringement, Igloo contended that Bradshaw could not rely upon the Doctrine of Equivalents to establish infringement. Igloo contended that prior art, including specifically the Mason patent, barred Bradshaw as a matter of law from relying on the Doctrine of Equivalents. The District Court concluded that Bradshaw could not rely on the Doctrine of Equivalents to establish infringement because the patent claims would be invalid over the prior art if two handle axles were considered the equivalent of the single handle axle claimed.

Bradshaw appealed to the Court of Appeals for the Federal Circuit (hereinafter the "Federal Circuit"). Bradshaw argued that the issue of whether the Igloo Cool Roller product infringed the Bradshaw patent claims under the Doctrine of Equivalents was entirely one of fact for the jury, *i.e.*, the District Court should not have been permitted to summarily decide that issue.

The Federal Circuit disagreed and affirmed the judgment of the District Court. The Federal Circuit decided that the District Court had reached the correct conclusion, but chose to affirm on grounds other than those relied upon by the District Court.

The Federal Circuit decided that where, as here, the patent claims at issue and the patent specification are clear in defining a critical element of the invention as a

single handle axle to which both a lifting handle and a pulling handle are coupled, that element is necessary to the claims as a matter of law. The Federal Circuit further concluded that the absence of this element from the Cool Roller product insulates the product from infringement under the all elements rule recited in *Pennwalt Corp. v. Durand-Wayland, Inc.*, 833 F.2d 931 (Fed. Cir. 1987) (in banc). Specifically, the Federal Circuit said that:

> "As we held in Bradshaw's previous appeal to this court, the patent is extremely clear that the pulling handle and the nearby lifting handle are both attached to the same axle. *See Bradshaw*, 1996 WL at **2. Specifically, our examination of claim 1 of the '841 patent reveals that Bradshaw disclosed a 'pulling handle coupled to one of the handle support axles.' There can be no doubt, then, that the pulling handle and one lifting handle must be attached to the same handle support axle. The language of claims 6 and 11 is equally precise. Moreover, the specification makes repeated reference to the fact that the pulling handle is attached to the same handle support axle as one of the lifting handles. *See, e.g.*, '841 pat., col. 1, II. 31032; col. 2, II. 63-64; col. 3, II. 1-3. Thus, one element of the '841 patent must be a handle support axle to which both a lifting handle and a pulling handle are attached. That element or limitation is entirely missing in the accused cooler and thus equivalent infringement fails under *Pennwalt*'s all-element or all-limitations rule. *See, Pennwalt*, 833 F.2d at 935, 4 USPQ2d at 1740."

Bradshaw now contends in the Petition that the Federal Circuit panel which decided the case has violated the

dictates of that Court's majority by creating a new category of cases in which a patent can be denied a jury determination of equivalence. Bradshaw contends that there are only three judicially approved situations in which a jury determination of equivalence can be avoided as a matter of law: one, where the patent prosecution history estops the patentee from proving that a particular feature of the accused device is covered by a patent claim; two, where prior art limits the extent to which the literal language of claims can be hypothetically expanded to cover an accused device; and three, where the District Court makes a determination that no reasonable jury could find equivalence. In the present case, according to Bradshaw, the Federal Circuit panel has erred by making a factual determination that there was no equivalence "under the guise of applying an alternative rule of law," *i.e.*, a rule of law other than one of the aforedescribed three.

To remedy this perceived error, Bradshaw petitions this Court to instruct the Federal Circuit that the "equivalence" issue, in its entirety, should be one of fact for a jury. This Court is thus asked by Bradshaw to take the step which it found unnecessary to take in *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 117 S. Ct. 1040 (1997), where it said (520 U.S. at 38):

> "whether, or how much of the application of the Doctrine of Equivalents can be resolved by the court is not necessary for us to answer."

As a policy based reason for this Court to grant their Petition, Bradshaw suggests that the twelve (12) judges of the Federal Circuit are divided on the issue of whether application of the Doctrine of Equivalents is for judge or

jury. Bradshaw further suggests that this Court's reluctance to decide the issue is creating uncertainty in a fundamental area of patent law. Finally, Bradshaw suggests that there is ample evidence for a jury to find infringement under the Doctrine of Equivalents in the present case.

ARGUMENT OPPOSING ALLOWANCE OF THE WRIT

I. THE PETITION SHOULD BE DENIED BECAUSE THERE IS NO VALIDITY TO BRADSHAW'S ARGUMENT THAT THE JUDGES OF THE FEDERAL CIRCUIT ARE IN DISARRAY ON THE ISSUE OF WHETHER APPLICATION OF THE DOCTRINE OF EQUIVALENTS IS FOR JUDGE OR JURY

The twelve judges of the Federal Circuit, sitting *in banc* in *Hilton Davis Chem. Co. v. Warner-Jenkinson Co., Inc.*, 62 F.3d 1512 (Fed. Cir. 1995), *rev'd and remanded*, 520 U.S. 17, 117 S. Ct. 1040 (1997), disagreed, seven (7) to five (5), regarding the extent to which the Doctrine of Equivalents determination should be for the fact finder or the Court. The seven judge majority concluded that the determination should be made in the same manner that it had been for many years, with a fact determination of gross equivalence if legal limitations did not bar the way. Four dissenting judges believed that the determination was entirely for the court, as a matter of equity. A fifth dissenting judge separated the determinations but called for element-by-element comparison.

The two issues are: whether the patentee is legally prevented from asserting infringement under the Doctrine of Equivalents and, if not, whether there is

structural and functional equivalence between the elements of a properly construed claim and an accused device. The former was, and is to this day, a question of law for a court. The latter was, and is to this day, a question of fact for the jury.

The three judges of the Federal Circuit who sat on the panel in the present case, Judges Rich, Michel and Clevenger, had all been in the *in banc* majority in the case below, *i.e.*, in *Hilton Davis Chem. Co. v. Warner-Jenkinson Co., supra*. Thus, when the panel decided the present case they were obviously very much in tune with that *in banc* majority. They decided unanimously that the fact question, *i.e.*, whether there was structural and functional equivalence between the elements of the Bradshaw patent claims and the accused Cool Roller product, was not reached in this case because the all-elements rule of law had been violated, whereby the Doctrine of Equivalents could not be relied upon to prove infringement. Thus, they decided this case in precisely the procedural manner approved by this Court. *Warner-Jenkinson Co. v. Hilton Davis Chem. Co., supra*.

Bradshaw sought rehearing of the Federal Circuit decision. Bradshaw suggested that the rehearing be *in banc* to determine, as a matter of law, whether application of the all elements rule required a factual determination of equivalence as part of the analysis. The Federal Circuit denied the motion for rehearing.

Against this background, what the Bradshaw Petition appears to be arguing is that any Federal Circuit panel containing a majority of the dissenting judges from the *in*

banc minority in *Hilton Davis Chem. Co. v. Warner-Jenkinson Co., supra,* might decide a future case contrary to established rules for deciding Doctrine of Equivalents cases. How such a speculative decision could be made in light of this Court's opinion in *Warner-Jenkinson Co. v. Hilton Davis Chem. Co., supra,* and the Federal Circuit's denial of rehearing here is not clear, however. What is clear is that the panel in the present case and this Court are in concert on the proper way to handle Doctrine of Equivalents cases.

II. THE PETITION SHOULD BE DENIED BECAUSE THE ONLY ISSUE RAISED BY THIS CASE IS WHETHER THE CLAIMS HAVE BEEN PROPERLY CONSTRUED AS A MATTER OF LAW AND THERE IS NO UNCERTAINTY ENGENDERED AS TO HOW THE DOCTRINE OF EQUIVALENTS SHOULD BE APPLIED

In their Petition, Bradshaw recites the aforedescribed "three known rules of law under which a patent holder may be denied a jury determination of equivalence: prosecution history estoppel, prior art and a determination that no reasonable jury could find equivalents." However, a fourth rule of law under which a patent holder may be denied a jury determination of equivalence is ignored, the all elements or all limitations rule. In guidance offered by this Court in *Warner-Jenkinson Co., Inc. v. Hilton Davis Chem. Co., supra,* 520 U.S. at 39, footnote 8, the all elements rule was approved as a court determined limitation on the right to a jury determination of equivalence. As noted there by this Court, if a theory of equivalence (between a patent claim construed as a matter of law and

an accused device) "would entirely vitiate a particular claim element," summary judgment should be rendered by the court.

Here the Federal Circuit concluded that the Doctrine of Equivalents "may not legally cover the accused . . . device" because the Bradshaw patent claim limitation requiring a single handle axle to which both a lifting handle and a pulling handle were coupled was "entirely missing in the accused" device. The Federal Circuit concluded that, in the context of the plain meaning of the claim language and the patent disclosure, the all elements rule was violated by the Bradshaw theory of infringement and that summary judgment of non-infringement was proper. The potential jury question of whether the elements of the Bradshaw patent claims each find equivalents in the accused Cool Roller product could not be reached because, as a matter of law, a legal restriction on the extent to which a patentee can avoid the definitional and public notice functions of the statutory claiming requirement had been violated.

Bradshaw disputes the validity of this legal conclusion by arguing that the Federal Circuit should not have relied upon the all elements rule to deny access to a jury because, in this particular case, a jury would find the missing element to be present in the accused device in another form. Citing *Ethicon Endo-Surgery, Inc. v. United States Surgical Corp.*, 47 U.S.P.Q.2d 1272, 1280 (Fed. Cir. 1998), Bradshaw argues that by its very nature the all elements rule requires a fact determination, and that there is no indication such a fact determination was made here, either by the District Court or by the Federal Circuit panel. According to Bradshaw, the Federal Circuit's

application of the all elements rule entirely eliminates the rule and, as a matter of law, directly contradicts its decision in *Ethicon* only three months earlier. Igloo submits that this argument is without merit.

In *Ethicon*, the failure by an accused device to literally meet a claim limitation under the facts of that case did not amount to "specific exclusion" of an element from a patent claim as a matter of law. *Id.* at p. 1277. The *Ethicon* panel noted that such a legal bar to equivalence did exist, however. The *Ethicon* panel cited *Athletic Alternatives, Inc. v. Prince Mfg., Inc.*, 73 F.3d 1573, 1582, 1583 (Fed. Cir. 1996), in which the Federal Circuit determined that under the all elements rule a patent claim may be legally construed to specifically exclude structure. Unlike *Ethicon*, under the circumstances of the present case the Federal Circuit panel determined as a matter of law that there had been a specific exclusion. Judges Michel and Clevenger from the panel in the present case sat on the *Athletic Alternatives* panel.

Thus, the issue raised by the Federal Circuit panel's decision in the present case is merely whether the panel properly construed claim language in the Bradshaw patent as a matter of law, not whether it encroached upon the jury's domain in a Doctrine of Equivalents determination. No uncertainty in the law is engendered by the decision of the panel in this case, regardless of whether its legal construction of the claims was correct or incorrect. Igloo submits that its construction of the claims was correct.

The Bradshaw Petition also argues that access to a jury cannot be denied here on grounds that no reasonable

jury could find equivalence, because neither the District Court nor the Federal Circuit had spoken on this subject. Since the Federal Circuit did not rely on this rule, however, the argument is not relevant.

III. THE PETITION SHOULD BE DENIED BECAUSE THE DECISION BELOW WAS CORRECT, AND WILL HAVE NO EFFECT OUTSIDE THE CONFINES OF THIS CASE

In support of the argument that sufficient evidence was present for a jury to find infringement under the Doctrine of Equivalents, Bradshaw paraphrases the Federal Circuit in *Sage Products, Inc. v. Devon Industries, Inc.*, 126 F.3d 1420, 1424 (Fed. Cir. 1997). At page 16 of the Petition it is stated that "the doctrine of equivalents protects a patent holder from infringement where only minor or insubstantial charges have been made from a claimed invention while retaining its essential functionality." Bradshaw argues that such is the situation here.

Igloo submits, however, that the *Sage Products* decision is more in point for what the Federal Circuit stated later in the same opinion, *i.e.*, at 126 F.3d 1424 and 1425. Quoting from its own precedent, the Federal Circuit reiterated its position that the Doctrine of Equivalents cannot be used to erase meaningful structure and functional limitations of the claim on which the public is entitled to rely in avoiding infringement. It further stated that where no subtlety of language or complexity of technology, nor any subsequent change in the state of the art obfuscated the significance of a claim limitation at the time it was incorporated in a claim, it is the patentee and not the

public who must bear the cost of its failure to seek protection for a foreseeable alteration of its claimed structure. Otherwise, the patentee is allowed to file and prosecute narrow claims in the U.S. Patent and Trademark Office (PTO) and then, during the course of litigation, expand its claim to exclusive rights under the Doctrine of Equivalents and avoid PTO examination of the expanded claim. Bradshaw now seeks to do just that. The Federal Circuit panel in the present case properly employed the all elements rule to prevent this finesse.

Bradshaw contends Igloo stipulated that the Bradshaw patent and the Cool Roller products were mechanical equivalents. Igloo entered into no stipulation. Igloo merely stated in a brief that, solely for the purpose of the summary judgment motion argument being made, the Cool Roller product could be considered the mechanical equivalent of the Bradshaw patent cooler, *i.e.*, both are wheeled coolers with a pulling handle on the end opposite the wheels. But that is not even the issue which a jury would be faced with here. The jury here would be asked to consider whether individual elements of the two coolers were only insubstantially different, if they were not the same.

Bradshaw also argues its technical expert testified that elements of the Cool Roller products were the same as, or only insubstantially different from, the Bradshaw patent claim elements. However, Bradshaw fails to note that the District Court specifically found their expert to be one who was not skilled in the art relevant to this patent. As such, his testimony effectively carried no weight.

Finally, Bradshaw refers to deposition testimony from Igloo witnesses and affidavits from Igloo's customers. As with Igloo's alleged stipulation, however, this evidence fails to deal with the relevant fact issue.

CONCLUSION

The Federal Circuit panel in the present case adhered to rules approved by the Supreme Court in guidelines for applying the Doctrine of Equivalents. The decision of the panel is consistent with relevant Federal Circuit precedent and manifestly correct on the merits. It engenders no uncertainty in the law related to application of the Doctrine of Equivalents. Igloo respectfully submits that the Bradshaw Petition should be denied.

Dated: March 5, 1999

Respectfully submitted,

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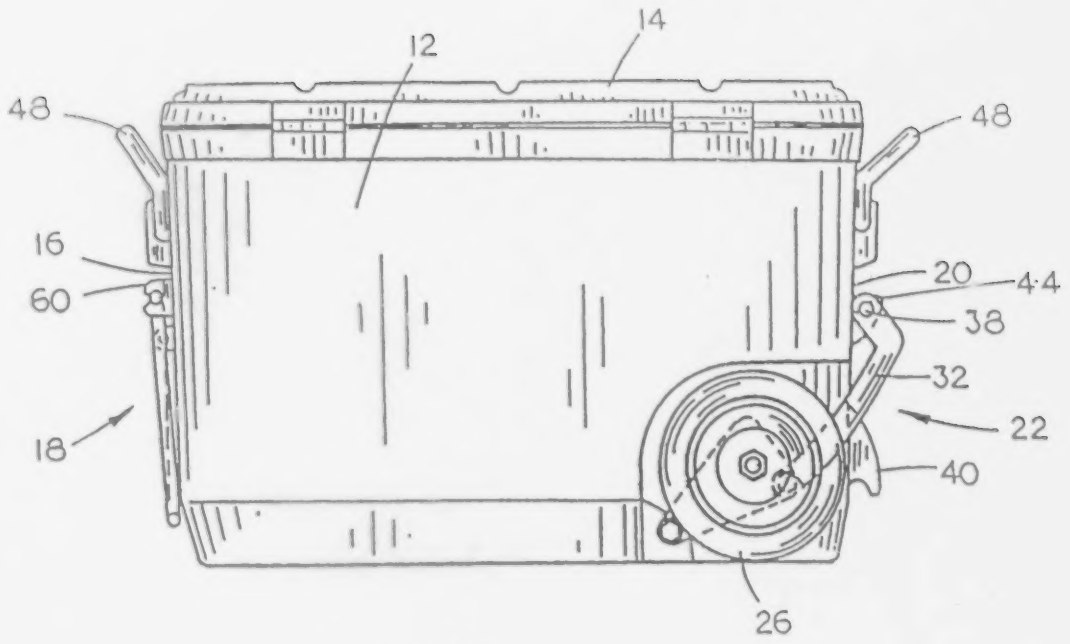


FIG. 3

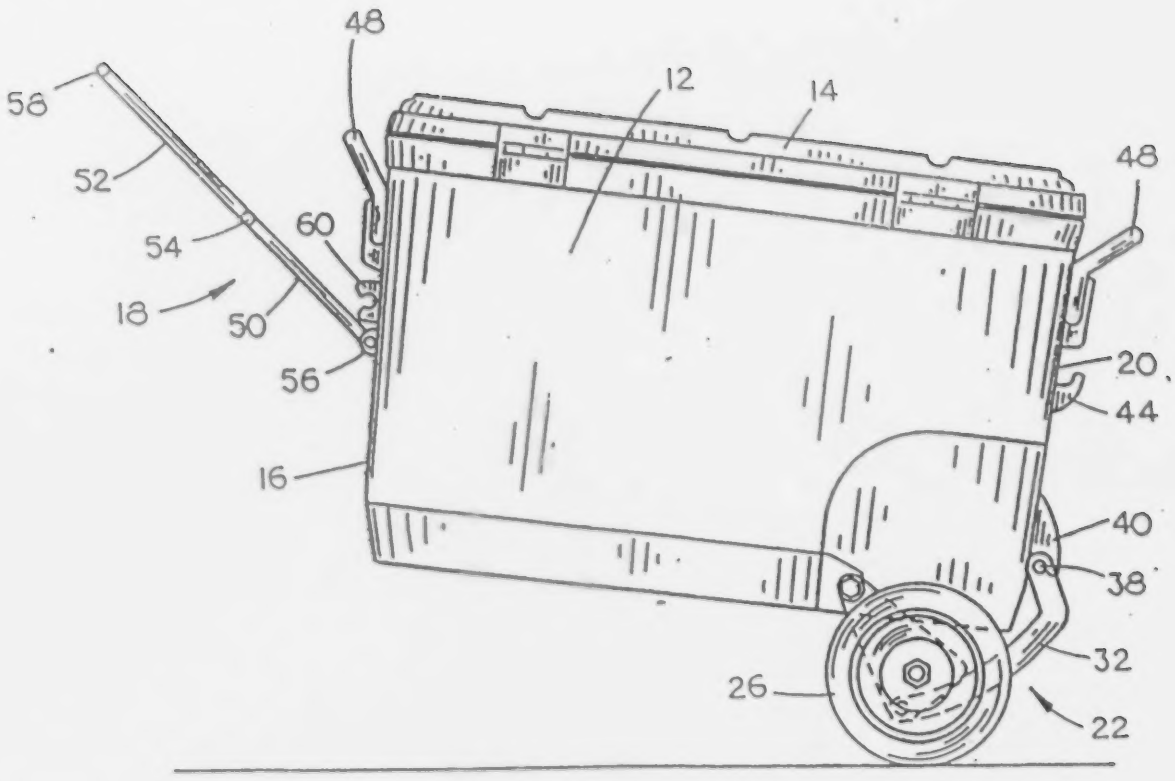


FIG. 4

App. 1

FIG. 1

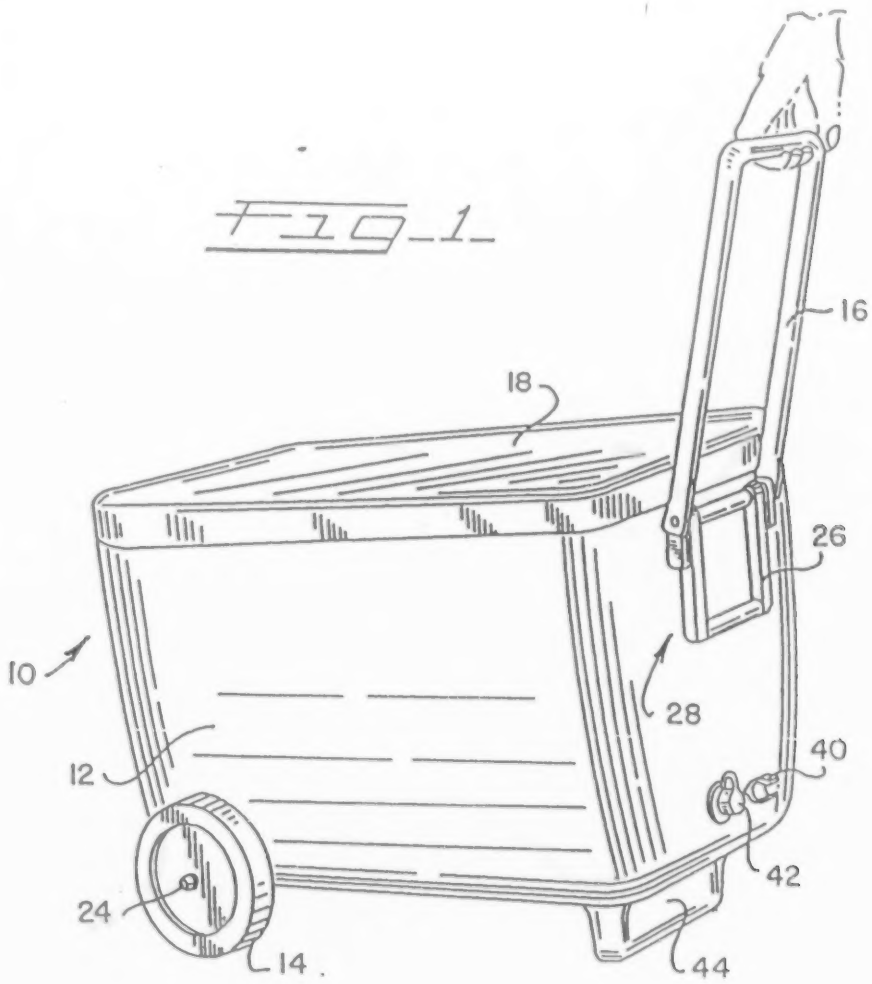
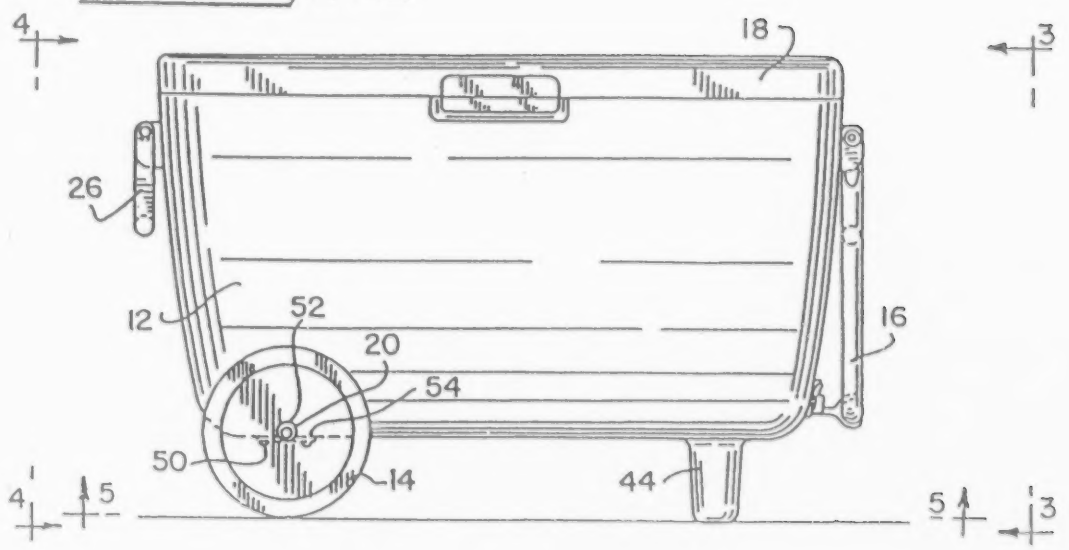


FIG. 2



App. 2